

REMARKS

The Office Action states that claims 2, 9 and 15 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Accordingly, claim 1 has been amended to incorporate the subject matter of dependent claim 2, (which has been cancelled), and claims 9 and 15 have been amended to incorporate all the limitations of their respective base claims. Thus, claims 1, 9 and 15 as now amended should be allowable. Claims 3-7 are dependent on the amended claim 1, and thus should also be allowable.

Claims 8, 11-14 and 17-20

Claims 8, 11-14 and 17-20 are rejected under 35 U.S.C. § 103(a) over Rimback U.S. Patent No. 5,685,109 in combination with Clemmons U.S. Patent No. 4,858,374.

Claims 8 and 11-12

The independent claim 8 has been amended to more clearly distinguish over the prior art. This claim is directed to a carpenter bee trap that includes a housing that contains "no bait" and having a hole "about the same size as holes normally made by carpenter bees," which applicant's specification teaches to be less than about 1/2 inch. Claim 8 distinguishes over Rimback in several ways.

First, claim 8 specifically requires a housing "containing no bait." Rimback describes an insect trap that uses bait such as "a carbohydrate, typically a sweet fruit juice and/or a protein such as meat, raw fish, cat food, or hamburger." The patent specifically states that, "The bait should be replaced every day for greatest effectiveness."

Second, claim 8 requires a hole of "about the same size as holes normally made by carpenter bees," which applicant's specification teaches to be less than about 1/2 inch. Rimback's trap has two entrance holes, but he says nothing about the size of the holes.

The explanation of the rejection of claim 8 in the rejection makes no mention of the Clemmons patent. In any event, the Clemmons patent discloses a "bee" (apparently meaning yellow jackets – see col. 1, ll. 10-11) trap that is made of a transparent material so that an attractant material inside the trap "will be visible to bees which is believed to enhance the attracting effect." (Col. 2, ll. 6-7) Applicant's claim 8 has been amended to incorporate the subject matter of claim 10, specifically requiring that the housing not only contain no bait, but

also: “the exterior surface of said solid wall around said hole having a light color, and the walls of said housing being opaque so that said hole appears dark from outside the housing.” Thus, applicant’s trap takes a fundamentally different approach from that of Clemmons – applicant relies on the opaque, light-colored housing and the resultant dark hole to attract carpenter bees, while Clemmons relies on a transparent housing and an attractant that is visible through the transparent walls to attract yellow jackets. Clemmons’ holes will not appear dark in a transparent wall. Consequently, even if Clemmons were combined with Rimback, the resulting combination would not yield applicant’s invention as defined by claim 8.

It is respectfully requested that the rejection of claim 8 for “obviousness” based on the combination of Rimback and Clemmons be reconsidered. Rimback discloses non-analogous art (i.e., a baited trap) and does not meet the required criteria for using a reference to reject an invention under § 103(a). Even assuming, *arguendo*, that Rimback is analogous art (which it is not) and could be applied under § 103(a), the Rimback and Clemmons combination nonetheless fails because no *prima facie* case of obviousness has been established. For example, the rejection does not properly consider applicant’s invention as a whole, including the problem applicant’s invention solves, in combining Rimback and Clemmons. In addition, there is no persuasive suggestion to combine the teachings of Rimback and Clemmons.

“[I]dentification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.” *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000), (*citing In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998)). “When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references.” *Rouffet*, 149 F.3d at 1355, 47 U.S.P.Q.2d at 1456, (*citing In re Geiger*, 815 F.2d 686, 688, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987)). A *prima facie* case of obviousness can *only* be set up where there is “a teaching or suggestion within the prior art, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources of information, to select particular elements, and to combine them in the way they were combined by the inventor.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1998); *see also In re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992); *In re Fine*, 837 F.2d

1071, 1074, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988). Evidence of a suggestion, teaching, or motivation to combine “must be clear and particular.” *Ex parte Maruyama*, 2001 WL 1918556, *3 (Bd. Pat. App. & Inter. 2001), (citing *C.R. Bard, Inc. v. M3 Systems Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)).

To render the claimed invention obvious, the Examiner “must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000), (quoting *In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998)). Obviousness cannot “be established using hindsight or in view of the teachings or suggestions of the invention.” *Ex parte Maguire* (Appendix 9), 2002 WL 1801466, *3 (Bd. Pat. App. & Inter. 2002), (quoting *Para-Ordnance Mfg. Inc. v. SGS Importers Int’l Inc.*, 73 F.3d 1085, 1087, 37 U.S.P.Q.2d 1237, 1239 (Fed. Cir. 1995), *cert. denied*, 519 U.S. 822 (1996)). In other words, the knowledge to combine “*can not* come from the applicant’s invention itself.” *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992), *emphasis added*.

Section 103(a) mandates that the “invention as a whole . . . must be considered in obviousness determinations.” *In re Wright*, 848 F.2d 1216, 1219, 6 U.S.P.Q.2d 1959, 1961 (Fed. Cir. 1988). The invention as a whole includes the “structure, its properties, and the problem it solves.” *Wright*, 848 F.2d at 1219, 6 U.S.P.Q.2d at 1961. The determination of obviousness “requires cognizance of the properties of which structure and the problem which it solves, viewed in light of the teachings of the prior art.” *Wright*, 848 F.2d at 1219, 6 U.S.P.Q.2d at 1961, (citing *In re Rinehart*, 531 F.2d 1048, 1054, 189 U.S.P.Q.2d 143, 149 (C.C.P.A. 1976)). The relevant question in an obviousness determination is “whether what the inventor did would have been obvious to one of ordinary skill in the art attempting to solve the problem upon which the inventor was working.” *Wright*, 848 F.2d at 1219, 6 U.S.P.Q.2d at 1961-62, (citing *Rinehart*, 531 F.2d at 1054, 189 U.S.P.Q.2d at 149); *see also In re Benno*, 768 F.2d 1340, 1346, 226 U.S.P.Q. 683, 687 (Fed. Cir. 1985).

The specific problem addressed by the applicant here was to create a baitless trap especially for carpenter bees. As discussed above, both the Rimback baited trap and the

Clemmons yellow jacket trap deal with completely different issues requiring completely different solutions than those encountered in attempting to trap carpenter bees without the use of bait.

The rejection does not show that a person of ordinary skill, seeking to solve problems related to trapping carpenter bees without the use of bait, would reasonably be expected or motivated to look to Rimback or Clemmons. It is, thus, clear that the rejection has not considered applicant's claimed invention as a whole, including the problem applicant's invention solves, in combining Rimback and Clemmons. No *prima facie* case of obviousness has been established. See *Wright*, 848 F.2d at 1219, 6 U.S.P.Q.2d at 1961; *Rinehart*, 531 F.2d at 1054, 189 U.S.P.Q.2d at 149; *Benno*, 768 F.2d at 1346, 226 U.S.P.Q. at 687.

Nor does the rejection establish why one of ordinary skill in the art would have found it obvious to combine Rimback and Clemmons to achieve the claimed invention and, instead, improperly uses knowledge from applicant's invention to make the Rimback-Clemmons combination. See *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000), (*quoting In re Rouffet*, 149 F.3d 1350, 1359, 47 U.S.P.Q.2d 1453, 1459, (Fed. Cir. 1998)). Because no persuasive suggestion to combine the teachings of Rimback and Clemmons has been presented, a *prima facie* case of obviousness has not been made. See *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1998); *In re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988).

The explanation of the rejection of claim 8 in the rejection makes no mention whatever of the Clemmons patent, and thus there is not a single word of explanation to support the rejection based on the combination of the two references. The rejection summarily concludes that it would have been obvious to one skilled in the art to modify the baited trap of Rimback with some unidentified feature of Clemmons, which is a non-analogous reference in any event. Obviousness, however, requires more than such unsupported summary conclusions. See *Ex parte Maruyama*, 2001 WL 1918556, *3 (Bd. Pat. App. & Inter. 2001), (*citing C.R. Bard, Inc. v. M3 Systems Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998)); *see also In re*

Dembiczak, 175 F.3d 994, 999-1000, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), *abrogated on other grounds by In re Gartside*, 203 F.3d 1305, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000).

Because of the noted differences between the issues and solutions of Rimback and Clemmons, the motivation, teaching or suggestion to make the proposed combination *must* have been impermissibly derived using hindsight or using applicant's own teachings. *See Maguire*, 2002 WL 1801466 at *3, (quoting *Para-Ordnance Mfg. Inc. v. SGS Importers Int'l Inc.*, 73 F.3d 1085, 1087, 37 U.S.P.Q.2d 1237, 1239 (Fed. Cir. 1995), *cert. denied*, 519 U.S. 822 (1996)); *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443, 1446 (Fed. Cir. 1992), emphasis added.

For these reasons, the rejection fails to establish why one of ordinary skill in the art would have found it obvious to combine Rimback and Clemmons and, thus, fails to establish a *prima facie* case of obviousness. *See Dembiczak*, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617; *Rouffet*, 149 F.3d at 1359, 47 U.S.P.Q.2d at 1459.

Furthermore, as discussed above, any combination of Rimback and Clemmons will fail to yield applicant's claimed invention in any event, particularly in light of the amendments that have been made to the independent claim 8.

Claims 14 and 17-19

The independent claim 14 is a method claim directed specifically to the use of a baitless structure to trap carpenter bees "without the use of bait or insecticide." There is no teaching whatever in the Rimback patent that his structure might be effectively used as a trap without the use of bait, nor that it might be used to trap carpenter bees. Rimback describes an insect trap that uses bait such as "a carbohydrate, typically a sweet fruit juice and/or a protein such as meat, raw fish, cat food, or hamburger." The patent specifically states that, "The bait should be replaced every day for greatest effectiveness." Moreover, claim 14 requires a hole of "about the same size as holes normally made by carpenter bees," which applicant's specification teaches to be less than about 1/2 inch. Rimback's trap has two entrance holes, but he says nothing about the size of the holes.

The explanation of the rejection of claim 14 makes no mention of the Clemmons patent. In any event, the Clemmons patent discloses a "bee" (apparently meaning yellow jackets – see col. 1, ll. 10-11) trap that is made of a transparent material so that an attractant material inside the

trap "will be visible to bees which is believed to enhance the attracting effect." (Col. 2, ll. 6-7) Applicant's claim 14 has been amended to incorporate the subject matter of claim 20, specifically requiring that the housing not only contain no bait, but also: "the exterior surface of said solid wall around said hole having a light color, and the walls of said housing being opaque so that said hole appears dark from outside the housing." Thus, applicant's trap takes a fundamentally different approach from that of Clemmons – applicant relies on the opaque, light-colored housing and the resultant dark hole to attract carpenter bees, while Clemmons relies on a transparent housing and an attractant that is visible through the transparent walls to attract yellow jackets. Clemmons' holes will not appear dark in a transparent wall. Consequently, even if Clemmons were combined with Rimback, the resulting combination would not yield applicant's invention as defined by claim 14.

Applicant's invention is superior to the references' approaches from an environmental standpoint, and yet, is surprisingly effective in trapping carpenter bees in large numbers. For example, the test results of record were conducted with four traps that were about 2" deep by 8" high by 6" wide, with entry holes of 5/16", 3/8", 7/16" and 1/2", respectively.

The rejection of claims 14 and 17-19 should be reversed for the same additional reasons set forth above with respect to claim 8.

Claim 13 and 20

Claims 13 and 20 are rejected under 35 U.S.C. § 103(a) over Rimback and Clemmons.

Claims 13 and 20 are dependent on claims 8 and 14, respectively, which distinguish over Rimback and Clemmons in the manners discussed above. Claims 13 and 20 add a requirement that the hole have a size "within the range of from about 5/16 inch to 1/2 inch," which also is not shown by Rimback. The rejection of these two claims relies on Clemmons to show a hole within the size range of applicant's claims 13 and 20. However, as discussed in detail above, there is no basis for combining Rimback and Clemmons, and even if they are combined, they cannot yield applicant's invention as now defined by the amended independent claims 8 and 14.

Claims 10 and 16

Claims 10 and 16 are rejected under 35 U.S.C. § 103(a) over Rimback U.S. Patent No. 5,685,109 in combination with Clemmons U.S. Patent No. 4,858,374 and Schneidmiller U.S. Patent No. 4,551,941.

As discussed above, the subject matter of claims 10 and 16 has been added to the corresponding independent claims 8 and 14, respectively. Although the dependent claims 10 and 16 have been cancelled, and the amended independent claims 8 and 14 have been discussed above, the Schneidmiller reference relied upon in the rejection of the original dependent claims 10 and 16 has not been addressed above.

Schneidmiller was relied upon to show “the use of a bright yellow color to attract wasps or the like.” Schneidmiller’s trap is designed specifically for wasps, and the particular characteristics of wasps as described in the Schneidmiller patent. Those characteristics include the tendency of a wasp to fly in an upward direction and toward a light source. Because of Schneidmiller’s desire to take advantage of these characteristics to trap wasps, the structure that he uses is actually diametrically opposed to the requirements of applicant’s carpenter bee trap as defined by claims 8 and 14. Applicant’s claims 8 and 14 both now require that the walls of the housing be “opaque so that said hole appears dark from outside the housing,” which is in sharp contrast to the teachings of Schneidmiller, who deliberately designs his trap with a light-transmitting wall surrounding the entry hole at the top of the cone 13. Schneidmiller’s light-transmitting wall satisfies his objective of providing a light source, not a dark hole, to attract the wasps:

Upper screen portion 46 defines a plurality of spaced
orifices that are small enough to prevent the passage of a wasp
therethrough, but large enough to allow passage of substantial light

. . . .

In addition, the body portion of Schneidmiller’s trap is also formed of a transparent plastic (col.2, ll.1-2) to illuminate the light-transmitting wall of his cone. Thus, it can be seen that Schneidmiller’s design criteria are the exact opposite of applicant’s: Schneidmiller wants an illuminated hole to attract wasps, whereas Applicant wants a dark hole to attract carpenter bees.

Moreover, there is no explanation in the rejection as to why it would have been obvious to one of ordinary skill in this art to combine any features of Schneidmiller's structure with the structures shown by Clemmons and Rimback. It is clear that the only basis for such an unusual combination are the teachings of the present applicant in the present application, and the hindsight application of those teachings in an attempt to combine two completely unrelated references. All the additional reasons set forth above with respect to the deficiencies in the rejection of claim 8 based on the purported combination of Rimback and Clemmons, are equally applicable to the three-way Rimback-Clemmons-Schneidmiller combination.

For all these reasons, the rejection fails to establish why one of ordinary skill in the art would have found it obvious to combine Rimback and Clemmons and Schneidmiller and, thus, fails to establish a *prima facie* case of obviousness. See *Dembiczak*, 175 F.3d at 999, 50 U.S.P.Q.2d at 1617; *Rouffet*, 149 F.3d at 1359, 47 U.S.P.Q.2d at 1459.


Conclusion

For the reasons set forth above, reconsideration of the rejections of applicant's claims 8, 11-14 and 17-20 is respectfully requested. Claims 1-7, 9 and 15 have been amended to place them in condition for allowance, in accordance with paragraph 8 of the Office Action.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

It is believed that no fee is presently due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 52372-00002USPT.

Respectfully submitted,

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